

# PATENT COOPERATION TREATY

# PCT

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference <b>ISIS-10621</b>	<b>FOR FURTHER ACTION</b>	See item 4 below
International application No. <b>PCT/US2005/033707</b>	International filing date ( <i>day/month/year</i> ) <b>19 September 2005 (19.09.2005)</b>	Priority date ( <i>day/month/year</i> ) <b>17 September 2004 (17.09.2004)</b>
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant <b>ISIS PHARMACEUTICALS, INC.</b>		

1.	This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 <i>bis</i> .1(a).																								
2.	<p>This REPORT consists of a total of 6 sheets, including this cover sheet.</p> <p>In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.</p>																								
3.	<p>This report contains indications relating to the following items:</p> <table style="width: 100%; border: none;"> <tr> <td style="width: 10%; text-align: center;"><input checked="" type="checkbox"/></td> <td style="width: 30%;">Box No. I</td> <td style="width: 60%;">Basis of the report</td> </tr> <tr> <td style="text-align: center;"><input checked="" type="checkbox"/></td> <td>Box No. II</td> <td>Priority</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td style="text-align: center;"><input checked="" type="checkbox"/></td> <td>Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td> </tr> <tr> <td style="text-align: center;"><input checked="" type="checkbox"/></td> <td>Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td style="text-align: center;"><input type="checkbox"/></td> <td>Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table>	<input checked="" type="checkbox"/>	Box No. I	Basis of the report	<input checked="" type="checkbox"/>	Box No. II	Priority	<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	<input checked="" type="checkbox"/>	Box No. VI	Certain documents cited	<input type="checkbox"/>	Box No. VII	Certain defects in the international application	<input type="checkbox"/>	Box No. VIII	Certain observations on the international application
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<input type="checkbox"/>	Box No. VIII	Certain observations on the international application																							
4.	The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).																								

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report <b>20 March 2007 (20.03.2007)</b>
Facsimile No. +41 22 338 82 70	Authorized officer <div style="text-align: center; font-weight: bold; margin-top: 10px;">Beate Giffo-Schmitt</div> e-mail: pt03.pct@wipo.int

# PATENT COOPERATION TREATY

REC'D 03 FEB 2006

WIPO

PCT

From the  
INTERNATIONAL SEARCHING AUTHORITY

PCT

To:

see form PCT/ISA/220

30/3

## WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing  
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference  
see form PCT/ISA/220

**FOR FURTHER ACTION**  
See paragraph 2 below

International application No.  
PCT/US2005/033707

International filing date (day/month/year)  
19.09.2005

Priority date (day/month/year)  
17.09.2004

International Patent Classification (IPC) or both national classification and IPC  
C12Q1/68, C12N15/10, H01J49/04

Applicant  
ISIS PHARMACEUTICALS, INC.

### 1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☒ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

### 3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



European Patent Office - P.B. 5818 Patentlaan 2  
NL-2280 HV Rijswijk - Pays Bas  
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Reuter, U

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**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US2005/033707

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**Box No. I Basis of the opinion**

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1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
  - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material:
    - ☐ a sequence listing
    - ☐ table(s) related to the sequence listing
  - b. format of material:
    - ☐ in written format
    - ☐ in computer readable form
  - c. time of filing/furnishing:
    - ☐ contained in the international application as filed.
    - ☐ filed together with the international application in computer readable form.
    - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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**Box No. II Priority**

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1. ☐ The validity of the priority claim has not been considered because the International Searching Authority does not have in its possession a copy of the earlier application whose priority has been claimed or, where required, a translation of that earlier application. This opinion has nevertheless been established on the assumption that the relevant date (Rules 43*bis*.1 and 64.1) is the claimed priority date.
2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.
3. Additional observations, if necessary:

**see separate sheet**

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US2005/033707

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**Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

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1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	1-23
Inventive step (IS)	Yes: Claims	
	No: Claims	1-23
Industrial applicability (IA)	Yes: Claims	1-23
	No: Claims	

2. Citations and explanations

**see separate sheet**

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**Box No. VI Certain documents cited**

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1. Certain published documents (Rules 43bis.1 and 70.10)

and /or

2. Non-written disclosures (Rules 43bis.1 and 70.9)

**see form 210**

**Re Item II. Priority**

For the present application a right of priority is claimed that is based on the national US American application 10/943344 dated 17.09.2004.

The subject matter of the present application is also the subject of the international application WO2004US015196 (filing date 13.05.2004, International publication number WO2004/101809).

Therefore the the national US American application 10/943344 dated 17.09.2004 cannot be considered as a first application for such subject matter in the meaning of Art.4 (C) of the Paris Convention. According to Art.8(2)(a)PCT the conditions of Art. 4 of said Paris Convention apply in establishing whether a right of priority can be recognised under the provision of the PCT. Consequently, for reasons set out before, as the subject matter of the present application is already disclosed in WO2004/101809 no right of priority can be recognised that is based on the national US American application 10/943344 dated 17.09.2004. WO2004/101809, published 25.11.2004 is therefore considered as being prior art for the present application.

**Re Item V.**

1 Reference is made to the following documents:

D1: WO 2004/101809 A (ISIS PHARMACEUTICALS, INC; HOFSTADLER, STEVEN, A; CUMMINS, LENDELL, L) 25 November 2004 (2004-11-25)

2 **NOVELTY AND INVENTIVE STEP** (Art. 33(2) PCT and Art. 33(3) PCT)

2.1 D1 discloses a method of isolation of a nucleic acid amplification product from a solution comprising one or more electrospray incompatible reagents (p. 2 last par., p. 8 par. 2) comprising mixing said solution with a magnetic bead linked to an anion exchange functional group, isolating that magnetic bead from solution by application of a magnetic field and the removal of said solution (p. 6 l. 26-32), washing said bead with wash buffers (p. 7 par. 1), and eluting the amplification product with an electrospray compatible buffer (p. 7 par. 2). D1 discloses as well a corresponding

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING  
AUTHORITY (SEPARATE SHEET)**

International application No.

PCT/US2005/033707

automated liquid handler for dispensing and aspirating liquid (p. 8, par. 2), as well as the use of a 96 well plate for holding the mixtures (p. 8, par. 3). D1 consequently discloses a system comprising said technical features as well as a kit comprising a 96-well plate, an anion exchange functional group linked to a magnetic bead, a wash solution and an electrospray compatible buffer (s. above and claims 32,36 and 42). D1 thus discloses all the technical features of the independent claims 1, 13 and 15 in combination.

- 2.2 In the light of D1 dependent claims 2-12,14 and 16-23 do not appear to contain any additional features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty (Art. 33(2) PCT).
- 2.3 In the light of D1 claims 1-23 are not novel in the sense of Art. 33(2) PCT and consequently also do not meet the requirements of inventive step (Art. 33(3) PCT).